

REMARKS

I. Introductory Comments

In the Office Action under reply, a restriction and election of species has been required by the Examiner. Present below are: (1) applicants' traversals of the Examiner's grouping of the claims and election of species; (2) applicants' election of a claim group and species; and (3) an explanation of the foregoing amendment to the claims.

II. Claim Amendments

Claims 1 and 2 have been amended to include "hydroxyl" in the group from which R⁶, R⁷, R⁸ and R⁹ are independently selected. For at least the following reason, this amendment does not introduce new matter: support for the amendment can be found in paragraph [00068] on page 14 of the original specification, which states that "R⁶, R⁷, R⁸, and R⁹ are independently selected from the group consisting of: hydrogen; hydroxyl..."

III. Restriction groups identified by the Examiner

Restriction to one of the following inventions has been required by the Examiner:

- I. Claims 1-29, drawn to a chemical compound and a pharmaceutical composition of formula (I).
- II. Claims 30-39, drawn to a method of treating cancer using a chemical compound of formula (I)
- III. Claims 40-47, drawn to a chemopreventive method using a chemical compound of formula (I).

IV. Species Election Requirement

A species election has also been required by the Examiner, in which applicants are required to elect a single disclosed species for prosecution on the merits.

In addition, if Group II or III is elected, the Examiner has required the applicant to elect a specific cancer to be treated.

V. Response to Restriction

In response to the restriction requirement, applicants elect Group I, i.e., Claims 1-29, drawn to a chemical compound and a pharmaceutical composition of formula (I), without traverse. However, applicants respectfully wish to traverse the grouping of the claims, and submit that claims 30-47 are not properly divided into separate groups.

MPEP § 821.04 states that "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." Accordingly, to the extent that treatment methods and chemopreventive methods utilizing compounds of formula (I) may be withdrawn from further consideration as being non-elected due to the restriction requirement, it is understood that claims drawn to these aspects of the elected invention may be rejoined at the appropriate time.

VI. Response to Species Election

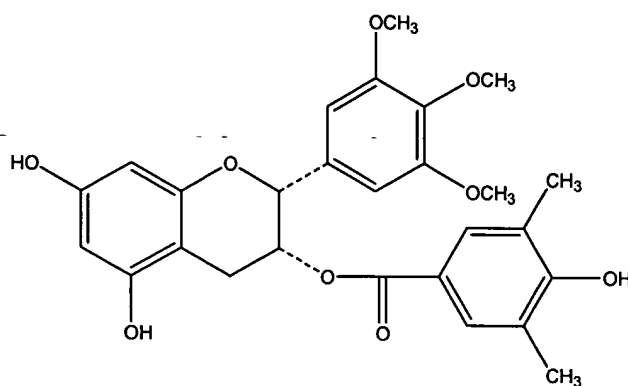
In Section 3 (on page 2) of the communication under response, the Examiner states that "[t]his application contains claims directed to the following patentably distinct species of the claimed invention: R¹, R², R³, R⁴, R⁶, R⁷, R⁸, and R⁹. The ring system and radicals within the definition of R¹, R², R³, R⁴, R⁶, R⁷, R⁸, and R⁹ are diverse in scope." Furthermore, the Examiner states that "the ring systems and the radicals are independent and patentably distinct."

Applicants traverse the election of species requirement. R¹, R², R³, R⁴, R⁶, R⁷, R⁸, and R⁹ are not "species of the claimed invention," as stated by the Examiner, but rather represent classes of *substituents* that may be present on the compounds of the invention. Therefore, applicants submit that characterization of R¹, R², R³, R⁴, R⁶, R⁷, R⁸, and R⁹ as species is not proper, and respectfully request withdrawal of the election of species requirement.¹

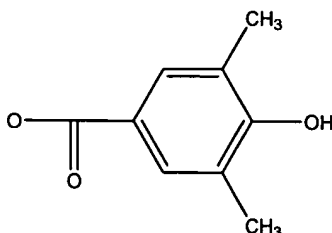
Because it is not clear what species the Examiner is asking the applicants to elect between, but applicants are nonetheless required to make an election, applicants further elect the species encompassing compound SR13196, as shown on page 35 of the application and having the structure

¹ The Examiner further states that R¹ being quinolinyl in a prior art reference would not render obvious R¹ being naphthyl. This statement is mysterious because R¹ can be neither quinolinyl nor naphthyl in any of the claims. R¹ is limited in claim 1 to "hydroxyl, halo, sulfhydryl, alkoxy, aryloxy, and aralkyloxy."

SR13196



For this compound, $R^1 = \text{OCH}_3$, $R^2 = \text{OCH}_3$, $R^3 = \text{OCH}_3$, $R^4 = \text{O}$, $R^5 =$



$R^6 = \text{OH}$, $R^7 = \text{H}$, $R^8 = \text{OH}$, $R^9 = \text{H}$, $R^{10} = \text{H}$, and $R^{11} = \text{H}$. Claims 1-4, 7-10, 14-20, 23-32, 35-42, and 45-47 are believed to read upon, or be generic to, the elected species.

Applicants note that this election of an ultimate species is for the purpose of the Examiner's initial search and examination, and that all generic (linking) claims must be examined as required by MPEP 809 and 814.

VII. Traversal of Claim Groupings

The division of claims 30-47 into Groups II and III by the Examiner is respectfully traversed for at least the following reasons. Claims 30-39 (i.e., those parsed into Group II) are directed toward treatment of cancer – i.e., a method of use of compounds of formula (I). Claims 40-47 (i.e., those parsed into Group III) are directed toward chemoprophylaxis of cancer – i.e., also a method of use of compounds of formula (I). These methods of use are not properly subject to restriction, as they are not independent inventions (as required by 35 U.S.C. 121). As described in MPEP §802.01, "[t]he term 'independent' (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect..." However, treatment of cancer and chemoprophylaxis of cancer are connected in that they are both methods directed toward avoiding the deleterious effects of

the disease. Indeed, "preventative treatment" is a common medical term that refers to the application of measures designed to protect a person from attack of a disease. For at least the foregoing reasons, restriction of claims 30-47 into Groups II and III is improper and applicants respectfully request withdrawal of the grouping of the claims.

If the Examiner has any questions about this amendment and response, or would like to discuss the application, the art, or other pertinent matters, she is welcome to contact the undersigned at 650-251-7724.

Respectfully submitted,

By:



Isaac Rutenberg
Registration No. 57,419

REED IP Law Group
1400 Page Mill Road
Palo Alto, California 94304
(650) 251-7700 Telephone
(650) 251-7739 Facsimile